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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,266	02/09/2001	Lawrence M. Sherman	07473-032	6278
30623	7590	08/08/2006	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/780,266	SHERMAN, LAWRENCE M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Natalie A. Pass	3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-49,51-54 and 59-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-49,51-54 and 59-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 8 March 2006. Claims 27-49, 51-52, and 54 have been amended. Claims 1-26, 50, 55-58 have been cancelled. Claims 59-63 have been newly added. Claims 27-49, 51-54, 59-63 remain pending.

2. Examiner notes that when amending claims, the text of any added or deleted subject matter must be shown by properly marking the added or deleted text. However, Examiner notes that, for example, in claim 45 at line 2, the words "outcome of " appear to be added subject matter to claim 45, as they have not been recited in previous claim recitations, however the lack of underlining makes this unclear. For the purpose of applying art, Examiner assumes this limitation to read "...receiving, as part of said input data, outcome of one or more risk reduction procedures ..."

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Newly added claims 63 and 63 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claims 62 and 63 recite limitations that are new matter, and are therefore rejected.

The added material which is not supported by the original disclosure is as follows:

- " the second insurance policy covers at least one risk different from at least one risk the first insurance policy covers," as disclosed in claim 62 at lines 1-2;
- "the second insurance policy covers at least one risk that is the same as at least one risk the first insurance policy covers," as disclosed in claim 63 at lines 1-2.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 9 February 2001. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

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5. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 9 February 2001.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Newly added claim 60 and amended claims 27, 28, 29 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 60 recites "said secondary life insurance" on line 24; and

(B) Claim 27 recites "said primary life insurance" on line 4 and "said secondary life insurance" on line 5;

(C) Claim 28 recites "said primary life insurance" on line 2;

(D) Claim 29 recites "said primary life insurance" on line 2;

(E) Claim 36 recites "said primary life insurance" on line 5;

There is insufficient antecedent basis for these limitations.

For the purpose of applying art, Examiner assumes the limitations to read "said secondary insurance, " wherever they currently recite "said secondary life insurance" and to read "said primary insurance" wherever they currently recite "said primary life insurance."

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Other claims, which are not listed, also contain language that results in insufficient antecedent basis. The applicant is encouraged to review the claim language to find other instances of lack of antecedent basis in the claims.

8. The rejection of claims 32 and 34 under 35 U.S.C. §112, second paragraph, is hereby withdrawn due to the amendment filed 8 March 2006.

***Claim Rejections - 35 USC § 101***

9. The rejection of claims 26-49 under 35 U.S.C. §101 is hereby withdrawn due to the amendment filed 8 March 2006.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 27-30, 36, 44-45, 51-54, 59-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Underwood, et al., U.S. Patent Number 5, 873, 066.

(A) As per newly added claim 59, Underwood teaches a computer-implemented method for providing additional insurance for one or more persons as a secondary insurance policy provided by a secondary insurer based on an underwriting evaluation a select primary insurer uses to determine the eligibility of said one or more persons for a primary insurance policy, the computer-implemented method comprising:

providing a computer configured for receiving input data and for processing and converting said input data into output data defining said secondary insurance policy, said secondary insurance policy being independent in effect from and without affect to said primary insurance policy and any benefits of said primary insurance policy (Underwood; column 1, lines 36-39, column 2, lines 10-14);

receiving, as part of said input data, one or more underwriting “guidelines” (reads on “standards”) said select primary insurer uses in said underwriting evaluation to determine the eligibility of said one or more “insured[s]” (reads on “persons”) for said primary insurance policy (Underwood; column 2, lines 20-33),

processing and converting said input data into said output data includes determining whether said one or more underwriting standards meets one or more criteria said secondary insurer applies to select a primary insurer from a plurality of primary insurers and to determine if

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said secondary insurer can rely upon said underwriting evaluation of said select primary insurer to determine the eligibility of said one or more persons for said secondary insurance policy (Underwood; column 2, lines 42-47, column 4, lines 46-56);

receiving, as part of said input data, information identifying said one or more persons and at least one secondary benefit amount of said secondary insurance policy (Underwood; column 2, lines 42-51);

processing and converting said input data into said output data includes determining eligibility of said one or more “insured[s]” (reads on “persons”) for said secondary insurance policy based on said one or more underwriting “guidelines” (reads on “standards”) and said secondary benefit amount, if said one or more underwriting standards meets said one or more criteria of said secondary insurer (Underwood; column 2, lines 36-48);

generating, as part of said output data, an indication of acceptance of said one or more persons for said secondary insurance policy (Underwood; column 6, lines 11-14); and

using said output data to define said secondary insurance policy, said secondary insurance policy creating an obligation of said secondary insurer to pay said secondary benefit amount independent of said primary insurance policy and any benefits of said primary insurance policy (Underwood; column 6, lines 11-14, 50-55).

(B) Newly added claim 60 differs from method claim 59, in that it is a system rather than a method for providing additional insurance for one or more persons as a secondary insurance policy provided by a secondary insurer.

System claim 60 repeats the subject matter of claim 59, respectively, as a set of elements



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rather than a series of steps. As the underlying processes of claim 59 have been shown to be fully disclosed by the teachings of Underwood in the above rejection of claim 59, it is readily apparent that the system disclosed by Underwood includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 59, and incorporated herein.

(C) Newly added claim 61 differs from method claim 59, in that it is a method of providing additional insurance as a secondary insurance policy rather than a computer-implemented method for providing additional insurance for one or more persons as a secondary insurance policy.

As per the recitation of “computer-implemented” in the preamble as compared to not being implemented on a computer, this variation does not present a patentable distinction over the applied prior art of record and independent claim 61 is therefore rejected for the same reasons given above for claim 59.

The remainder of claim 61 recites substantially the same limitations as claim 59, and is therefore rejected for the same reasons provided for that claim and incorporated herein.

(F) As per claims 27-30, 36, 44-45, Underwood teaches a method as analyzed and discussed in claim 59 above,

further comprising receiving, as part of said input data, information relating to one or more terms of said primary life insurance policy and further determining eligibility of said one or more “insured[s]” (reads on “persons”) for said secondary insurance policy based on said one or more terms (Underwood; Abstract, column 2, lines 48-52);

wherein the said one or more terms includes a benefit amount of said primary life insurance policy (Underwood; column 2, lines 48-52);

wherein said one or more terms includes a date of issuance of said primary life insurance policy (Underwood; Figure 7, column 3, lines 30-35);

wherein said one or more terms includes an expiration date of said primary life insurance policy (Underwood; Figure 7, column 3, lines 30-35);

further comprising receiving, as part of said input data, information related to one or more “guidelines” (reads on “standards”) used by said primary insurer to determine eligibility of said one or more “insured[s]” (reads on “persons”) for said primary life insurance policy (Underwood; column 2, lines 20-33);

further comprising receiving, as part of said input data, information from at least one of said one or more persons in response to one or more queries and further determining eligibility of said one or more “insured[s]” (reads on “persons”) for said secondary life insurance policy based on said response information (Underwood; column 2, lines 42-52, column 4, lines 46-56); and

further comprising receiving, as part of said input data, “documentation” (reads on “outcome”) of one or more risk reduction procedures and further determining eligibility of said one or more persons for said secondary life insurance policy based on said risk reduction procedure outcome (Underwood; Figure 8, Figure 9, column 2, lines 42-52, column 5, lines 1-7, column 6, lines 11-14).

(G) As per claims 51-54, Underwood teaches a system as analyzed and discussed in claim 60 above

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wherein said one output device operatively connected to the broker computer is configured for transmitting to said customer computer via the network information regarding said secondary life insurance policy (Underwood; Figure 2, column 4, lines 4-9);

wherein the broker computer is communicatively connected to at least one primary insurer computer via the network (Underwood; Figure 2, column 4, lines 4-9);

wherein the broker computer and the primary insurer are communicatively connected to one or more databases via the network, the one or more databases including information related to at least one of; the one or more persons, the primary life insurance policy and the primary insurer (Underwood; Figure 2, column 4, lines 4-9); and

wherein the broker computer is communicatively connected to one or more databases via the network, the one or more databases including information related to at least one of the one or more persons, the primary life insurance policy and the primary insurer (Underwood; Figure 2, column 4, lines 4-9).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Newly added claims 62, 63, and claim 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Underwood, et al., U.S. Patent Number 5, 873, 006.

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(A) As per newly added claims 62-63, Underwood teaches a method as analyzed and discussed in claim 61 above.

Underwood fails to explicitly disclose

wherein the second insurance policy covers at least one risk different from at least one risk the first insurance policy covers; and

wherein the second insurance policy covers at least one risk that is the same as at least one risk the first insurance policy covers.

However, the above features are well known in the art, and Underwood clearly teaches “the user enters into the system the name of the primary carrier (or U/L carrier), and the coverage type [reads on “risk” type] and coverage limits of the primary insurance policy” (Underwood; column 4, lines 22-25) and then “[n]ext ... the user selects one or more of the coverage types [reads on “risk” type(s)] which are applicable to the excess casualty insurance policy [reads on “secondary in insurance policy”] being quoted” (Underwood; column 5, lines 25-27).

It is respectfully submitted that since Underwood is directed to “managing insurance underwriting and related processes associated with the excess casualty [reads on “secondary”] insurance business” where “the purpose of an excess [reads on “secondary”] insurance policy is to cover an insured in the event that the insured incurs liability that is in excess of the coverage limits of its primary insurance policy” (Underwood; column 1, lines 10-12, 18-21), and since Underwood’s teaches the user selecting different “coverage types” or risks for the primary policy and then, separately, for the secondary policy, Underwood’s teachings as recited in the above passages, broadly reads on the claimed “wherein the second insurance policy covers at least one risk different from at least one risk the first insurance policy covers” and “wherein the second

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insurance policy covers at least one risk that is the same as at least one risk the first insurance policy covers.”

It is the position of the Examiner that one having ordinary skill in the art at the time of the invention would have found it obvious to include these limitations within the method disclosed by Underwood, with the motivations of “providing a system for quoting excess [reads on “secondary”] insurance which requires the quoted premium to accurately reflect the risks associated with a policy, and which permits the auditing of the risk characteristics, rating and pricing methodology associated with a quote before it is issued” (Underwood; column 1, line 65 to column 2, line 3).

(B) As per claim 31, Underwood teaches a method as analyzed and discussed in claims 59 and 27 above.

Underwood fails to explicitly disclose

wherein said one or more terms includes one or more conditions that would, if met, void said primary life insurance policy.

However, the above features are well known in the art, and Underwood clearly teaches “[p]rimary insurance carrier ...records are also stored in the database. Each of the primary insurance carrier ... records includes a field for storing a rating code ... associated with a primary insurance carrier... for documenting and storing ... code[s] and related underwriting criteria associated with the policy” and “it is important for all relevant information pertaining to the ... policy to be properly documented and permanently stored at the time that the policy is initially issued” and “[a]t the time of binding, the insurance business producer is required to enter into the

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system information relating to the reinsurance of the policy which has been bound” (Underwood; Abstract,; column 1, lines 45-49, column 6, lines 38-41).

It is respectfully submitted that since Underwood is directed to “managing insurance underwriting and related processes associated with the excess casualty [reads on “secondary”] insurance business” where “the purpose of an excess [reads on “secondary”] insurance policy is to cover an insured in the event that the insured incurs liability that is in excess of the coverage limits of its primary insurance policy” (Underwood; column 1, lines 10-12, 18-21), and since Underwood’s teaches the importance of “documenting an insured’s limits, attachment points, contract duration and for retrieving public bureau ... information regarding underlying carrier(s),” (Underwood; column 3, lines 30-34), Underwood’s teachings as recited in the above passages, broadly reads on the claimed limitations.

It is the position of the Examiner that one having ordinary skill in the art at the time of the invention would have found it obvious to include these limitations within the method disclosed by Underwood, with the motivations of “providing a system for quoting excess [reads on “secondary”] insurance which requires the quoted premium to accurately reflect the risks associated with a policy, and which permits the auditing of the risk characteristics, rating and pricing methodology associated with a quote before it is issued” and ensuring that “all relevant information pertaining to the ... policy ... [is] ... properly documented and permanently stored” (Underwood; column 1, line 48 to column 2, line 3).

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14. Claims 32-35, 37-43, 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Underwood, et al., U.S. Patent Number 5, 873, 066, as applied to claims 59 and 36 above, and further in view of Ryan, et al., U.S. Patent Number 5, 673, 402.

(A) As per claims 32-35, Underwood teaches a method as analyzed and discussed in claims 59 and 27 above.

Underwood fails to explicitly disclose a method

wherein said one or more terms includes one or more statements received from at least one of said one or more persons in connection with the health of one of said one or more persons;

wherein said one or more terms of the primary life insurance policy includes an age of at least one of said one or more persons;

wherein said one or more terms of said primary life insurance policy includes the total number of said one or more persons; and

wherein said one or more terms of said primary life insurance policy includes one or more conditions precedent to payment of said benefit amount.

However, the above features are well-known in the art, as evidenced by Ryan.

In particular, Ryan teaches a method

wherein said one or more terms includes one or more statements received from at least one of said one or more persons in connection with the health of one of said one or more persons (Ryan; column 19, lines 14-25);

wherein said one or more terms of the primary life insurance policy includes an age of at

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least one of said one or more persons (Ryan; column 19, lines 14-25);

wherein said one or more terms of said primary life insurance policy includes the total number of said one or more persons (Ryan; column 31, lines 31-36, column 46, lines 25-29);

wherein said one or more terms of said primary life insurance policy includes one or more conditions precedent to payment of said benefit amount (Ryan. Column 1, lines 19-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Underwood to include these recited limitations, as taught by Ryan, with the motivations of providing a computerized insurance system capable of identifying potentially higher risk individuals and providing specialized insurance values for those individuals (Ryan; column 6, lines 11-14).

(B) As per claims 37-43, Underwood teaches a method as analyzed and discussed in claims 59 and 36 above.

Underwood fails to explicitly disclose

wherein said one or more standards includes one or more statements received from at least one of said one or more persons in connection with said person's health;

wherein said one or more standards includes an age of at least one of said one or more persons; and

wherein said one or more standards includes a profession at least one of said one or more persons;

wherein said one or more standards includes a benefit amount of said primary life insurance policy;



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wherein said one or more standards includes a term during which said primary life insurance policy is effective;

wherein said one or more standards includes one or more responses received from at least one of said one or more persons in response to one or more antiselection questions; and

wherein said secondary benefit amount is less than a primary benefit amount provided under said primary life insurance policy.

However, the above features are well-known in the art, as evidenced by Ryan.

In particular, Ryan teaches

wherein said one or more standards includes one or more statements received from at least one of said one or more persons in connection with said person's health (Ryan; column 19, lines 14-24, column 33, line 61 to column 34, line 12);

wherein said one or more standards includes an age of at least one of said one or more persons (Ryan; column 7, line 51 to column 8, line 1, (Ryan; column 19, lines 14-24, column 33, line 61 to column 34, line 12); and

wherein said one or more standards includes "employment" data (reads on "a profession at least one of said one or more persons") (Ryan; column 33, line 61 to column 34, line 12, column 39, lines 6-9);

wherein said one or more standards includes a benefit amount of said primary life insurance policy (Ryan; column 19, lines 14-24);

wherein said one or more standards includes a term during which said primary life insurance policy is effective (Ryan; column 22, lines 23-26);

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wherein said one or more standards includes one or more responses received from at least one of said one or more persons in response to one or more antiselection questions (Ryan; column 19, lines 34-35); and

wherein said secondary benefit amount is less than a primary benefit amount provided under said primary life insurance policy (Ryan; column 11, lines 9-26, 41-54).

The motivations for combining the respective teachings of Underwood and Ryan are as given in the rejection of claim 32 above, and incorporated herein.

(C) As per claims 46-47, Underwood and Ryan teach a method as analyzed and discussed in claims 59 and 45 above

wherein one or more risk reduction procedures includes establishing a period of time during which an offer for said secondary life insurance policy is effective (Ryan; column 19, lines 10-27); and

wherein one or more risk reduction procedures includes establishing a period of time within which a payment of a premium said the secondary life insurance policy is “scheduled” (reads on “required”) (Ryan; column 9, line 64 to column 10, line 4).

The motivations for combining the respective teachings of Underwood and Ryan are as given in the rejection of claim 32 above, and incorporated herein.

15. Claims 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Underwood, et al., U.S. Patent Number 5, 873, 066, as applied to claim 59 above, and further in view Pescitelli, et al., U.S. Patent Number 5, 845, 256.

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(A) As per claims 48-49, Underwood teaches a method as analyzed and discussed in claim 59 above.

Underwood fails to explicitly disclose a method

further comprising receiving, as part of said input data, at least one beneficiary of said secondary life insurance policy; and

wherein said at least one beneficiary of said secondary life insurance policy includes at least one beneficiary of said primary life insurance policy.

However, the above features are well-known in the art, as evidenced by Pescitelli.

In particular, Pescitelli teaches

further comprising receiving, as part of said input data, at least one beneficiary of said secondary life insurance policy (Pescitelli; column 11, lines 20-29, column 13, lines 7-14); and

wherein said at least one beneficiary of said secondary life insurance policy includes at least one beneficiary of said primary life insurance policy (Pescitelli; column 11, lines 20-29, column 13, lines 7-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Underwood to include establishing beneficiaries of the life insurance policies, as taught by Pescitelli, with the motivations of providing an improved system, and method, for vending insurance contracts (Pescitelli; column 2, lines 49-52).

***Response to Arguments***

16. Applicant's arguments filed 8 March 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 8 March 2006.

(A) Applicant's arguments on pages 9-12 of the response filed 8 March 2006 with respect to rejections under 35 USC § 112 and 35 USC § 101 have been considered and, together with amendments to the claims, have resulted in withdrawal of the previously applied rejections.

(B) Applicant's arguments on pages 12-20 of the response filed 8 March 2006 with respect to claims 27-49, 51-54, 59-63 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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**18. Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:** (571) 273-8300.

For formal communications, please mark  
"EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

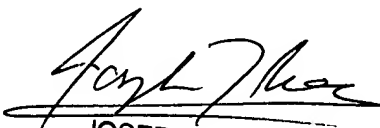
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21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

June 26, 2006



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER